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KINYA WASHINO

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GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C

PO BOX 7021

TROY, MI 48007-7021

EXAMINER

DIEP, NHON THANH

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2621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/301,656

Applicant(s)

WASHINO ET AL.

Examiner

Nhon T. Diep

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17, 18, 25-36, 38, 41-47, 49-57 and 60-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 18, 25-36, 38, 41-47, 49-57 and 60-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Allowable Subject Matter

1. The indicated allowability of claims 1-7, 15, 17, 25-34, 36, 38, 41-43, 46-54, 57 and 60-74 is withdrawn in view of the newly discovered reference(s) to Boerger et al (US 4,650,929), Lobodzinski (US 5,619,995), and many others as indicated in the Court Filing with respect to Reissue Litigation (6/11/2009); and it is requested that all prior art as cited in the Court Filing Reissue Litigation be filed in correct form so it can be properly considered. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 52, 66 and 72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding to claim 52, which recites “wherein the separate computers are configured to display a subset of camera images which possess a particular common characteristic”. Since the specification does not disclose the above limitation, and therefore, the claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding to claim 66, In. 2-3 (similarly claim 72), which recites the searching of “**the**” video material on the first storage medium while continuing to store “**the**” material on the second storage medium. It is the examiner’s opinion that **the same video material** after being digitally compressed must be first stored in both the first and the second video storage media before **the same video material** can be then searched on the first storage medium (first storage medium can not search for **the same video material** since it does not contain **the same video material** at the time). And, therefore the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 44, 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 44 (In. 1, and similarly claim 49) recites the limitation “the” in “the high-capacity storage”. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 8-15, 25-32, 34-36, 41-42, 44-46, 49-51, 55-57, 60-61, and 75-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Boerger et al (US 4,650,929).

The reference of Boerger et al discloses a communication system for video conferencing comprising the same method of simultaneously displaying and storing multiple video images (fig. 2, el. 5-6 and 13), comprising the steps of:

receiving video images at a personal computer based system from one or more sources (fig. 1, col. 2, ln. 29-50, col. 7, ln. 29-33);

digitizing any of the images not already in digital form using an analog-to-digital converter (fig. 2, el. 9, col. 7, ln. 29-33);

displaying at least certain of the digitized images in separate windows on a personal computer based display device, using a first, predetermined frame rate and resolution associated with each window (figs. 8-10, col. 4, ln. 6-9, 37-49, col. 7, ln. 29-33 and col. 8, ln. 62-64);

converting one or more of the video source images into a data storage format using a second, predetermined frame rate and resolution associated with each image, and simultaneously storing the converted images in a memory device (fig. 2, el. 5-6, col. 3, ln. 44-51; col. 7, ln. 12-15 and ln. 37-43) as specified in claims 8, 25; further including the step of receiving a command to set the frame rate and resolution associated with the display and storage of a particular image (fig. 12, el. 32, col. 9, ln. 5-23) as specified in claims 9, 26; wherein the command is based upon an operator input (col. 9, ln. 5-8) as specified in claims 10, 27; wherein the command is based upon an external stimulus (col. 9, ln. 5-8) as specified in claims 11, 28; wherein one or more video images or

camera control signals are received through a network connection (fig. 1, el. 1-36-30) as specified in claims 34, 41; wherein the high-capacity storage media includes a removable or permanent magnetic, magneto-optical, optical or semiconductor device (fig. 2, el. 5-6) as specified in claims 44, 49; including a display device associated with each source and a communication capability enabling an operator situated at the display for one source to view images, in separate windows, gathered by one or more different sources (figs. 8-10) as specified in claim 55; whereby the displayed image and the stored image are at the same frame rate and resolution (col. 7, ln. 29-43) as specified in claim 75; the method of simultaneously displaying and storing multiple video images (fig. 2, el. 5-6 and 13), comprising the steps of:

receiving video images at a personal computer based system from one or more sources (fig. 1, col. 2, ln. 29-50, col. 7, ln. 29-33);

digitizing any of the images not already in digital form in an analog-to-digital converter (fig. 2, el. 9, col. 7, ln. 29-33);

displaying at least certain of the digitized images in separate windows on a personal computer based display device, using a first set of temporal and spatial parameters associated with each image in each window (figs. 8-10, col. 4, ln. 6-9, 37-49, col. 7, ln. 29-33 and col. 8, ln. 62-64);

converting one or more of the video source images into a data storage format using a second set of temporal and spatial parameters associated with each image; and simultaneously storing the converted images in a memory device (fig. 2, el. 5-6, col. 3, ln. 44-51; col. 7, ln. 12-15 and ln. 37-43) as specified in claims 12, 29; the temporal

parameters including frame rate (col. 4, ln. 43-53) as specified in claims 13, 30; the spatial parameters including image dimension in pixels (col. 7, ln. 29-43) as specified in claims 14, 31; wherein one or more video images or camera control signals are received through a network connection (fig. 1, el. 1-36-30) as specified in claims 35, 42; wherein the high-capacity storage media includes a removable or permanent magnetic, magneto-optical, optical or semiconductor device (fig. 2, el. 5-6) as specified in claims 45, 50; including a display device associated with each source and a communication capability enabling an operator situated at the display for one source to view images, in separate windows, gathered by one or more different source (col. 7, ln. 29-43) as specified in claim 56; whereby the displayed image and the stored image are at the same temporal and spatial parameters (col. 7, ln. 29-43) as specified in claim 76; a video storage and display system (figs. 1 and 2), comprising:

one or more video cameras, each outputting a signal representative of a video image (col. 2, ln. 39-42, 61-64, and col. 7, ln. 29-33);

means to receive the signals from each camera and digitally compress the images (fig. 2, el. 9); and

a computer configured to receive the digitally compressed images, the computer being interfaced to the following devices (col. 7, ln. 44-49);

a display screen (fig. 1, el. 47);

means to receive externally derived operator commands including means for sensing a deviation from the normal- state image scene associated with at least one of

the video cameras, the existence of the deviation being used as the basis for generating an externally derived command (col. 2, ln. 22-50), and

a high-capacity storage medium, and programmed to perform the following functions (figs. 1-2, el. 5-6; and col. 3, ln. 43-47, col. 7, ln. 12-15, 37-43);

display the digitally compressed images from the cameras in different windows on the display screen, each window being associated with an update rate and dimensions in pixels (figs. 8-10, col. 4, ln. 6-9),

vary the dimensions and the rate at which a particular image is updated in its window in accordance with one of the externally derived commands (col. 2, ln. 39-50);

store the digitally compressed images in the high-capacity storage medium, and vary the dimensions and the rate at which a particular image is stored in accordance with one of the externally derived commands (col. 2, ln. 39-50, col. 3, ln. 43-47, col. 7, ln. 12-15, 37-43) as specified in claim 15; further including a device for remotely controlling the operation of one or more of the video cameras (col. 3, ln. 10-20 and col. 5, ln. 41-56) as specified in claim 32; wherein one or more video images or camera control signals are received through a network connection (fig. 1, el. 1-36-30) as specified in claim 36; wherein the high-capacity storage media includes a removable or permanent magnetic, magneto-optical, optical or semiconductor device (fig. 2, el. 5-6) as specified in claim 46; further including a memory for storing the sensed deviation information in conjunction with the image data (col. 2, ln. 22-39) as specified in claim 51; further including:

a computer and display device associated with each video camera (fig. 2, el. 19 and figs 8-10); and

a communication capability enabling an operator situated at the display device associated with one camera to view images, in separate windows, gathered by one or more different cameras (col. 7, ln. 29-43) as specified in claims 57, 60-61.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-7, 17-18, 33, 38, 43, 47, 52-54, 62-65, 67-71 and 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boerger et al, in view of Lobodzinski (US 5,619,995).

Regarding to claims 1-7, 17-18, 33, 38, 43, 47, 52-54, as applied to claim 15, above, it is noted that the reference of Boerger et al further discloses further including means associated with the computer for controlling the operation of one or more of the video cameras (fig. 1, el. 30) as specified in claim 2; wherein the means to digitally compress the image from a particular camera is disposed at the location of the computer (col. 2, ln. 22-39, col. 7, ln. 29-33, fig. 1, el. 35, fig. 2, el. 9) as specified in claim 4; further including a separate computer associated with each camera, the computers being networked together over a common communication bus, enabling an operator situated at a particular computer to display the images gathered by other

cameras in separate windows on that operator's display screen (fig. 1, el. 1-36-35, figs. 8-10) as specified in claim 5; wherein one or more video images or camera control signals are received through a network connection (fig. 1, el. 1-36-35-30) as specified in claim 33; wherein one or more of the high-capacity storage media includes a removable or permanent magnetic, magneto-optical, optical or semiconductor device (fig. 2, el. 5-6) as specified in claim 43; wherein one or more video images is received through a network connection (fig. 1, el. 1-36-30) as specified in claim 38; and wherein the high-capacity storage media includes a removable or permanent magnetic, magneto-optical, optical or semiconductor device (fig. 2, el. 5-6) as specified in claim 47; however, it is noted that the reference to Boerger et al does not particularly disclose that two forms of a high-capacity video storage media; and a computer interfaced to the following devices; and wherein the high-capacity storage media include one being randomly searchable, and with the other being serially searchable as specified in claims 1, 17-18; wherein one or both of the high-capacity storage media comprises a magnetic tape as specified in claim 6; wherein one or both of the high-capacity storage media comprises a magnetic disk as specified in claim 7; wherein one or both of the high-capacity storage media comprises a recordable optical disc as specified in claim 53; wherein one or both of the high-capacity storage media comprises a recordable magneto-optical disc as specified in claim 54. Lobodzinski teaches two forms of high-capacity video storage media (RAM (random access memory) and CD-ROM (serially searchable memory)) and high-capacity storage media comprises a magnetic tape and a magnetic disk and a recordable optical disc and a recordable magneto-optical disc. Since all the claimed

elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art, and therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to combine the above two references to achieve what is claimed. Doing so would help to reduce the time to retrieve stored information.

Regarding to claims 62-65, 67-71 and 73-74, the reference of Boerger et al discloses the same digital video recording and monitoring system configured for use with a display device, comprising:

- an input for receiving video material having an image, size and a frame rate (fig. 1, el. 26);

- circuitry for digitally compressing the video material (fig. 2, el. 9);

- an output for delivering the video material to the display device (fig. 2, el. 19, figs 8-10);

- a user control; and

- processing hardware or software operative to perform the following functions under user control (col. 2, ln. 39-50, col. 3, ln. 43-47, col. 7, ln. 12-15, 37-43, col. 3, ln. 10-20 and col. 5, ln. 41-56);

- a) store the digitally compressed video material in one or both of the first and second video storage media (fig. 2, el. 5-6, col. 3, ln. 44-51; col. 7, ln. 12-15 and ln. 37-43), and

b) output the video material for monitoring to the display device (fig. 1, el. 27) as specified in claims 62 and 70; wherein the processing circuitry is operative to simultaneously store the digitally compressed video material in the first and second video storage media (fig. 2, el. 5-6, col. 3, ln. 44-51; col. 7, ln. 12-15 and ln. 37-43) as specified in claim 63; wherein the image size or frame rate of the video material in the first or second storage medium are different from the image size or frame rate of the video material delivered to the display device (col. 2, ln. 39-50, col. 3, ln. 43-47, col. 7, ln. 12-15, 37-43) as specified in claim 67; further including one or more video cameras interfaced to the input (col. 2, ln. 22-39) as specified in claim 68; further including:

a plurality of video cameras interfaced to the input (col. 2, ln. 22-39); and the video material from different cameras is visible in different windows on the display device (figs. 8-10) as specified in claim 69; and further including:

a plurality of video cameras interfaced to the input; and the video material from different cameras is visible in different windows on the display device (col. 7, ln. 29-43) as specified in claim 74. It is noted that the reference of Boerger et al does not particularly disclose a first video storage medium which is randomly addressable; a second video storage medium which is serially addressable; wherein the first video storage medium is a disk as specified in claim 64; wherein the second video storage medium is a tape as specified in claim 65; wherein the processing circuitry is operative to simultaneously store the digitally compressed video material in the video disk and video tape units as specified in claim 71; and wherein the image size or frame rate of the video material stored on the tape or disk are different

from the image size or frame rate of the video material output to the display device as specified in claim 73. Lobodzinski teaches the using of video disk and video tape for storing video information and also random access memory (RAM) and read only memory (CD-ROM). Since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art, and therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to combine the above two references to achieve what is claimed. Doing so would help to reduce the time to retrieve stored information.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boerger et al, in view of Lobodzinski (US 5,619,995), and further in view of Toyoshima (US 5, 229,850).

As applied to claim 1 above, it is noted that the combination of Boerger et al and Lobodzinski does not disclose wherein the means to digitally compress the image from a particular camera is disposed at the location of the camera as specified in claim 3. Toyoshima teaches to locate the means to digitally compress the image from a particular camera at the location of the camera (fig. 6, el. 14 or fig. 7, el. 14n and col. 5, ln. 42-49). Since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art, and therefore, it would have been

obvious to one of ordinary skilled in the art at the time the invention was made to combine the above two references to achieve what is claimed. Doing so would help to reduce the bit rate before transmitting.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon T. Diep whose telephone number is 571-272-7328. The examiner can normally be reached on m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Primary Examiner, Art Unit 2621